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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,794	02/01/2001	Norman G. Anderson	41039	2626
7590	02/18/2004			EXAMINER YANG, NELSON C
John C. Robbins Large Scale Biology Corporation 3333 Vaca Valley Parkway Suite 1000 Vacaville, CA 95688			ART UNIT 1641	PAPER NUMBER
DATE MAILED: 02/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/774,794	ANDERSON ET AL.
	Examiner	Art Unit
	Nelson Yang	1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 13 January 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 16-18 and 22-24 is/are pending in the application.  
 4a) Of the above claim(s) 1-15, 19-21 and 25-80 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 16-18 and 22-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1/28/04.                    6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 16-18 in paper filed on January 13, 2004 is acknowledged. The traversal is on the ground(s) that a patent with 80 claims is not unusual, particularly in the field of biotechnology. This is not found persuasive because the application contains multiple distinct and independent claims, and it would furthermore pose a serious burden on examiner to examine all the different inventions in the application.
2. Applicant, however, also argues that group III and V should be examined together, as they are a process of producing a product and a product itself and therefore would cover the same search and issues for patentability. Examiner does acknowledge that as long as the claims of group V remain in the same scope as the claims of group III, it would not necessarily pose a serious burden to examine groups III and V together. The inventions of groups III and V will therefore be examined together.
3. The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless

the references have been cited by the examiner on form PTO-892, they have not been considered.

***Claim Objections***

5. Claim 16 objected to because of the following informalities: claim 16 currently refers to a nonelected claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 16-18, and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 16 recites the limitation "the fiber bundle" in the first line. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of making array from the section created by cutting a fiber bundle transversely or at an angle. Claim 16 merely recites a method for making a section from a fiber bundle. Applicant may wish to incorporate the method step of claim 17 to overcome this rejection.

10. Claim 22 recites an array prepared by the method of claim 16. Claim 16, however, merely teaches how to make a fiber bundle section, rendering claim 22 indefinite.

11. The remainder of the claims are deemed indefinite due to their dependence on an indefinite claim.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. Claims 16, 17, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Wach et al [US 6,174,424].

14. With respect to claim 16, Wach et al teach an optical fiber bundle cut at an angle (column 27, lines 62-65) for creating a larger exit port for escaping rays.

15. With respect to claim 17, the method taught by Wach et al further comprises mounting the section to a solid support (a gradient optical element) (column 62, lines 3-23). Wach et al also teach a fiber bundle mounted to a thin PTFE plate (column 69, lines 45-62).

16. Claims 16-18, 22-24 rejected under 35 U.S.C. 102(e) as being anticipated by Landegren et al [US 6,140,135].

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17. With respect to claims 16, 17, 22, and 23, Landegren et al teach the bundling and fixing together of flat thin carrier elements in a regular way, each element having immobilized thereto a selected molecule and having an identifiable position in the array, sectioning the bundles and depositing the sections on a support (column 2, lines 1-50). Although Landegren et al do not specifically teach cutting the bundles transversely or at an angle, it should be pointed out in order cut the bundle, it must be done at some sort of angle. Furthermore, Landegren et al teach that the sectioning of the bundles results in "salami-like" slices (column 2, lines 33-35), indicating that the sectioning was done transversely.

18. With respect to claim 18 and 24, Landegren et al teach that bundle is sectioned in about 100  $\mu$ m sections, which is less than 1 cm thick (column 5, lines 5-8).

### ***Conclusion***

19. No claims are allowed.

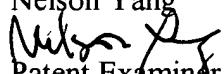
20. The following references are also cited as art of interest: Marinkovich [US 4,459,360], Marino [US 4,981,653], Walt et al [US 6,210,910], Wach et al [US 6,366,726].

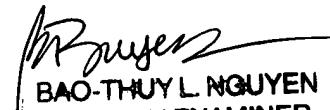
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson Yang  
  
Patent Examiner  
Art Unit 1641

  
BAO-THUY L. NGUYEN  
PRIMARY EXAMINER  
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